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EXAMINER

WASSUM, LUKE S

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2167

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/19/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/805,752

Applicant(s)

GOEDKEN, JAMES FRANCIS

Examiner

Luke S. Wassum

Art Unit

2167

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) 47-62 and 67-69 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-46 and 63-66 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The Invention

1. The claimed invention is a method and apparatus to search and analyze prior art by allowing a user to submit queries for different claim elements.

Election/Restrictions

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-46 and 63-66, drawn to document searching, classified in class 707, subclass 5.
 - II. Claims 47-60, drawn to selection of a prior art searcher, classified in class 707, subclass 104.1.
 - III. Claims 61 and 62, drawn to selectively displaying advertisements, classified in class 705, subclass 14.
 - IV. Claims 67-69, drawn to performing document searches of differing scopes, classified in class 707, subclass 1.

The inventions are distinct, each from the other because of the following reasons:

3. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the document searching claimed in Group I can be executed without performing the selection of a prior art searcher as claimed in Group II. The subcombination has separate utility such as selecting a prior art searcher.

4. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the document searching claimed in Group I can be executed without performing the displaying of advertisements as claimed in Group III. The subcombination has separate utility such as selecting an advertisement to be displayed.

5. Inventions I and VI are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the document searching claimed in Group I can be executed without performing the search incorporating different scopes as claimed in Group VI. The subcombination has separate utility such as performing a document search utilizing different keywords embodying different scopes.

The examiner has required restriction between combination and subcombination inventions. Where applicant elects a subcombination, and claims thereto are subsequently found allowable, any claim(s) depending from or otherwise requiring all the limitations of the allowable subcombination will be examined for patentability in accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may

be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

6. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with James F. Goedken on 4 December 2006 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-46 and 63-66. Affirmation of this election must be made by applicant in replying to this Office action. Claims 47-62 and 67-69 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 4, 37, 44 and 63-66 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10. Claim 63 recites the limitation "the third plurality of synonyms" and "the fourth plurality of synonyms" in the sixth step. There is insufficient antecedent basis for this limitation in the claim.

11. Claims 64-66, fully incorporating the deficiencies of their parent claim 63, are likewise rejected.

12. Further regarding claims 4, 37, 44 and 66, the addition of the conditional requirement to the ranking renders the claim indefinite, since the ranking required by parent claims 3, 36, 43 and 65 contradicts the ranking required by dependent claims 4, 37, 44 and 66. In other words, the ranking cannot be based upon a comparison of the scores (claims 3/36/43/65), and at the same time be based upon a comparison of the scores only if the zero counts are equal (claims 4/37/44/66).

13. Claims 4, 37, 44 and 66 recite the limitation "zero count elements". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 36 and 37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

16. Regarding claims 36 and 37, these claims recite a method of searching for prior art, but fails to recite a tangible result, a requirement for compliance with the provisions of 35 U.S.C. § 101 for a process that can be interpreted as being implemented through software.

For a result to be tangible, it must be more than just a thought or a computation; it must have real-world value rather than an abstract result. See *GOTTSCHALK, Comr. Pats. v. BENSON et al.* (US SupCt) 175 USPQ 673 at 676-77 (invention ineligible because it had "no substantial practical application"). For instance, an additional step that

included either storing the ranked documents in a database, or displaying said ranked documents to a user would constitute a tangible result. Claim 36, however, merely cites 'ranking the first document relative to the second document...' as the result.

Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

18. Claim 63 is rejected under 35 U.S.C. 102(e) as being anticipated by **Morgan et al.** (U.S. Patent Application Publication 2004/0186705).

19. Regarding claim 63, **Morgan et al.** teaches a method of searching for prior art as claimed, the method comprising:

- a) receiving a first word and a second word associated with a first claim element
(see disclosure of the user's submission of a request to edit an initial phrase in a document, paragraph [0004], lines 2-5);
- b) receiving a third word and a fourth word associated with a second claim element (see disclosure of the user's submission of a request to edit an initial phrase in a document, paragraph [0004], lines 2-5);
- c) retrieving a first plurality of synonyms associated with the first word (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14);
- d) retrieving a second plurality of synonyms associated with the second word (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14);
- e) determining a first subset of synonyms based on the first plurality of synonyms and the second plurality of synonyms, wherein a first member of the first subset is selected over a first non-selected synonym because the first member is in the first plurality of synonyms and the second plurality of synonyms, and the first non-selected synonym is not in the second plurality of synonyms (this step is deemed not patentably limiting, since **the determined subset** is never stored nor displayed to the user);

- f) determining a second subset of synonyms based on the third plurality of synonyms and the fourth plurality of synonyms, wherein a second member of the second subset is selected over a second non-selected synonym because the second member is in the third plurality of synonyms and the fourth plurality of synonyms, and the second non-selected synonym is not in the fourth plurality of synonyms (this step is deemed not patentably limiting, since **the determined subset** is never stored nor displayed to the user);
- g) causing at least a portion of the first subset of synonyms and at least a portion of the second subset of synonyms to be displayed to a prior art searcher (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14).

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

22. Claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 are rejected under 35 U.S.C.

103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et**

al. (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S.

Patent Application Publication 2005/0283453).

23. Regarding claim 1, **Bradford** teaches a method of searching for prior art

substantially as claimed, comprising:

- a) receiving a first synonym list from a user, the first synonym list including a first text string and a second text string (see disclosure that the user can

enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);

- b) receiving a second synonym list from a user, the second synonym list including a third text string and a fourth text string (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- c) executing a database query based on the first synonym list and the second synonym list to produce a query result, the query result identifying a first document and a second document (see disclosure that the query is executed and documents are retrieved, col. 5, lines 55-57; see also drawing Figure 2);
- d) calculating the number of occurrences of each of the text strings in each of the documents (see col. 5, lines 60-65); and
- e) transmitting data indicative of a chart based on the total numbers of occurrence of the text strings in the documents (see drawing Figure 2).

Bradford does not explicitly teach a method wherein the input synonym lists are treated as a single concept for the purposes of querying.

Morgan et al., however, teaches a system wherein concepts are represented as a number of 'standard concept phrases', which include common synonyms, misspellings and abbreviations (see paragraph 13, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize synonyms when searching for relevant documents, since failure to include all variants of a search term in a query will result in incomplete results (see **Bradford**, col. 1, lines 45-60).

Neither **Bradford** nor **Morgan et al.** explicitly teaches highlighting all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color.

Varadarajan, however, teaches a system that includes highlighting all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color (see paragraph [0005], lines 1-5; see also paragraph [0029], lines 6-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to highlight all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color, since this would enable a user to quickly locate multiple different concepts (see paragraph [0029], lines 6-11).

24. Regarding claim 38, **Bradford** teaches a method of searching for prior art substantially as claimed, comprising:

- a) receiving data indicative of a patent claim from a user (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- b) receiving data indicative of at least a first claim element and a second claim element selected from the patent claim (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- c) executing a database query based on the first claim element and the second claim element to produce a query result, the query result identifying a first document and a second document (see disclosure that the query is

executed and documents are retrieved, col. 5, lines 55-57; see also drawing Figure 2);

- d) calculating the number of occurrences of each of the claim elements in each of the documents (see col. 5, lines 60-65); and
- e) transmitting data indicative of a chart based on the total numbers of occurrence of the claim elements in the documents (see drawing Figure 2).

Bradford does not explicitly teach a method wherein the input claim elements are treated as a single concept for the purposes of querying.

Morgan et al., however, teaches a system wherein concepts are represented as a number of 'standard concept phrases', which include common synonyms, misspellings and abbreviations (see paragraph 13, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize synonyms when searching for relevant documents, since failure to include all variants of a search term in a query will result in incomplete results (see **Bradford**, col. 1, lines 45-60).

Neither **Bradford** nor **Morgan et al.** explicitly teaches highlighting all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color.

Varadarajan, however, teaches a system that includes highlighting all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color (see paragraph [0005], lines 1-5; see also paragraph [0029], lines 6-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to highlight all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color, since this would enable a user to quickly locate multiple different concepts (see paragraph [0029], lines 6-11).

25. Regarding claim 2, **Bradford** additionally teaches a method further comprising ranking the first document higher than the second document if the first sum is non-zero, the second sum is non-zero, and at least one of the third sum and the fourth sum is zero (see disclosure that all other things being equal, documents containing more terms

of interest should be ranked more highly than documents containing fewer terms of interest, col. 12, lines 54-56).

26. Regarding claim 11, **Varadarajan** additionally teaches a method including the use of an electronic thesaurus in presenting synonyms (see paragraph [0019], lines 10-12).

27. Regarding claim 12, **Morgan et al.** additionally teaches a method of searching for prior art comprising:

- a) retrieving a first plurality of synonyms associated with the first word (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14);
- b) retrieving a second plurality of synonyms associated with the second word (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14);
- c) retrieving a third plurality of synonyms associated with the third word (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14);

- d) retrieving a fourth plurality of synonyms associated with the fourth word (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14);
- e) determining a first subset of synonyms based on the first plurality of synonyms and the second plurality of synonyms, wherein a first member of the first subset is selected over a first non-selected synonym because the first member is in the first plurality of synonyms and the second plurality of synonyms, and the first non-selected synonym is not in the second plurality of synonyms (this step is deemed not patentably limiting, since **the determined subset** is never stored nor displayed to the user);
- f) determining a second subset of synonyms based on the third plurality of synonyms and the fourth plurality of synonyms, wherein a second member of the second subset is selected over a second non-selected synonym because the second member is in the third plurality of synonyms and the fourth plurality of synonyms, and the second non-selected synonym is not in the fourth plurality of synonyms (this step is deemed not patentably limiting, since **the determined subset** is never stored nor displayed to the user);

g) causing at least a portion of the first subset of synonyms and at least a portion of the second subset of synonyms to be displayed to a prior art searcher (see disclosure that an alternative phrase is displayed, paragraph [0004], lines 9-14).

28. Regarding claims 15, 16 and 23, **Bradford** additionally teaches a method performed over the Internet such that the highlighted documents are presented in HTML (see col. 1, lines 25-27).

29. Regarding claims 18-20, **Bradford** additionally teaches a method wherein the transmitting includes data indicative of at least one of a numerical chart and a graphical chart including a bar chart (see drawing Figure 2, illustrating the data).

30. Regarding claim 26, **Bradford** additionally teaches a method wherein the first and second documents, and the first and second highlighted documents are all electronic documents (see disclosure that the documents are contained on the Internet, col. 1, lines 25-27).

31. Regarding claim 35, **Bradford** additionally teaches a method further comprising receiving a third synonym list from a user, the third synonym list including at least one text string, wherein the first document does not include any of the at least one text string in the third synonym list (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1).

32. Regarding claim 39, **Bradford** additionally teaches a method wherein receiving data indicative of the patent claim from the user comprises receiving a text string representing the patent claim (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1).

33. Claims 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Jacobson et al.** (U.S. Patent 6,363,379).

34. Regarding claim 36, **Bradford** teaches a method of searching for prior art substantially as claimed, comprising:

- a) receiving a first synonym list from a user, the first synonym list including a first text string and a second text string (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- b) receiving a second synonym list from a user, the second synonym list including a third text string and a fourth text string (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- c) executing a database query based on the first synonym list and the second synonym list to produce a query result, the query result identifying a first document and a second document (see disclosure that the query is executed and documents are retrieved, col. 5, lines 55-57; see also drawing Figure 2);
- d) calculating the number of occurrences of each of the text strings in each of the documents (see col. 5, lines 60-65);
- e) transmitting data indicative of a chart based on the total numbers of occurrence of the text strings in the documents (see drawing Figure 2); and
- f) ranking the documents based upon the numbers of occurrence of the text strings in the documents (see disclosure that all other things being equal,

documents containing more terms of interest should be ranked more highly than documents containing fewer terms of interest, col. 12, lines 54-56).

Bradford does not explicitly teach a method wherein the input synonym lists are treated as a single concept for the purposes of querying.

Morgan et al., however, teaches a system wherein concepts are represented as a number of 'standard concept phrases', which include common synonyms, misspellings and abbreviations (see paragraph 13, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize synonyms when searching for relevant documents, since failure to include all variants of a search term in a query will result in incomplete results (see **Bradford**, col. 1, lines 45-60).

Neither **Bradford** nor **Morgan et al.** explicitly teaches the ranking being based upon the logarithms of the number of occurrences of the text strings in the documents.

Jacobson et al., however, teaches the use of the logarithm function to achieve a flattening effect (see col. 3, lines 32-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the logarithm functions in ranking, since the mere occurrence of a term of interest in a document in the absolute sense is more significant than the occurrence of said term one additional time, and the use of the logarithm function in determining ranking reflects this fact.

35. Regarding claim 37, **Bradford** additionally teaches a method including ranking the documents based upon the numbers of occurrence of the text strings in the documents when the number of zero count elements associated with the first document is equal to the number of zero count elements associated with the second document (see disclosure that all other things being equal, documents containing more terms of interest should be ranked more highly than documents containing fewer terms of interest, col. 12, lines 54-56).

36. Claims 3, 4, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **Jacobson et al.** (U.S. Patent 6,363,379).

37. Regarding claims 3 and 43, **Bradford**, **Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford**, **Morgan et al.** nor **Varadarajan** explicitly teach a method that uses the ranking being based upon the logarithms of the number of occurrences of the text strings in the documents.

Jacobson et al., however, teaches the use of the logarithm function to achieve a flattening effect (see col. 3, lines 32-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the logarithm functions in ranking, since the mere occurrence of a term

of interest in a document in the absolute sense is more significant than the occurrence of said term one additional time, and the use of the logarithm function in determining ranking reflects this fact.

38. Regarding claims 4 and 44, **Bradford** additionally teaches a method including ranking the documents based upon the numbers of occurrence of the text strings in the documents when the number of zero count elements associated with the first document is equal to the number of zero count elements associated with the second document (see disclosure that all other things being equal, documents containing more terms of interest should be ranked more highly than documents containing fewer terms of interest, col. 12, lines 54-56).

39. Claims 5, 6, 24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **Behrens et al.** (U.S. Patent 6,615,208).

40. Regarding claims 5, 6 and 46, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method wherein the entire document is withheld until the user purchases the document.

Behrens et al., however, teaches a method wherein documents are not fully disclosed to the user until the user has purchased the document (see drawing Figure 3; see also col. 5, lines 1-16).

It would have been obvious to one of ordinary skill in the art at the time of the invention to withhold a document until it has been purchased, since this would allow the proprietor of the information source to generate income.

41. Regarding claim 24, **Behrens et al.** additionally teaches a method wherein the documents can be delivered via hard copy (see disclosure in drawing Figure 3 that one media choice is 'Paper').

42. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **Drissi et al.** (U.S. Patent Application Publication 2005/0234898).

43. Regarding claims 13 and 14, **Bradford**, **Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford**, **Morgan et al.** nor **Varadarajan** explicitly teach a method that includes translating the query terms of interest from a first language to a second language before executing the query.

Drissi et al., however, teaches a method wherein query terms are translated from a first language to a second language prior to executing a query (see drawing Figure 3; see also paragraph [0026]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to translate query terms into a second language, since this would facilitate searching for documents in a repository that contains documents written in multiple languages (see paragraph [0002]).

44. Claims 7-10 and 40-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **Snyder et al.** (U.S. Patent 6,038,561).

45. Regarding claims 7-9, **Bradford**, **Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford**, **Morgan et al.** nor **Varadarajan** explicitly teach a method wherein additional documents are selected as a result of the entry of a patent number.

Snyder et al., however, teaches a method wherein additional documents are selected as a result of the entry of a patent number (see col. 26, lines 42-44; see also drawing Figure 11A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow a user to input a patent number since this would allow a user to indicate a specific patent which embodies the subject matter of the search without the need to formulate a query.

46. Regarding claim 10, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method further comprising receiving a patent number, wherein the query result excludes a patent document because the patent document is associated with the patent number.

Snyder et al., however, teaches a method further comprising receiving a patent number, wherein the query result excludes a patent document because the patent

document is associated with the patent number (see Patent Query window, including check box 1005 to filter claims from the patent queried, drawing Figure 10A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to exclude the patent document that corresponds to a submitted query, since the user submits the patent number in order to find patents *similar* to the given patent, not to present that patent.

47. Regarding claim 40, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method wherein receiving data indicative of a patent claim from the user comprises receiving a patent number.

Snyder et al., however, teaches a method wherein receiving data indicative of a patent claim from the user comprises receiving a patent number (see col. 26, lines 42-44; see also drawing Figure 11A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow a user to input a patent number since this would allow a user to indicate a specific patent which embodies the subject matter of the search without the need to formulate a query.

48. Regarding claim 41, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method wherein receiving data indicative of a patent claim from the user comprises receiving a claim number associated with the patent number.

Snyder et al., however, teaches a method wherein receiving data indicative of a patent claim from the user comprises receiving a claim number associated with the patent number (see col. 4, lines 25-28; see also drawing Figure 11A).

It would have been obvious to one of ordinary skill in the art at the time of the invention to allow a user to input a patent number since this would allow a user to

indicate a specific patent claim which embodies the subject matter of the search without the need to formulate a query.

49. Regarding claim 42, **Bradford** additionally teaches a method wherein receiving data indicative of at least the first claim element and the second claim element selected from the patent claim comprises receiving a word selection from the user (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1).

50. Claims 17, 21, 22, 25 and 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **Parker et al.** (U.S. Patent 6,038,561).

51. Regarding claims 17, 21, 22, 25 and 45, **Bradford**, **Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method wherein the highlighted documents are PDF files.

Parker et al., however, teaches the use of PDF files (see col. 1, lines 27-31).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use PDF files as a mechanism to transfer documents, since PDF files are device independent and highly portable (see col. 5, lines 50-65).

52. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **USPTO[1]** ("EAST Text Search Training").

53. Regarding claim 27, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method further comprising receiving a query date, wherein the query result excludes a patent document because the patent document is associated with a filing date that is after the query date.

USPTO[1], however, teaches a method further comprising receiving a query date, wherein the query result excludes a patent document because the patent document is associated with a filing date that is after the query date (see disclosure of the ability to perform a patent search that limits results by year or date, including the filing date, page 150).

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide the ability to filter results based on filing date, since searching for prior art explicitly would exclude patent documents whose filing date would disqualify it as prior art.

54. Claims 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **Pant et al.** (U.S. Patent 6,012,053).

55. Regarding claims 28-31, **Bradford**, **Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford**, **Morgan et al.** nor **Varadarajan** explicitly teach a method wherein the distance of the search terms within the documents contribute to the relevance determination of the document to the search query.

Pant et al. teaches a method wherein the distance of the search terms within the documents contribute to the relevance determination of the document to the search query (see col. 7, lines 22-30).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize distance between the search terms, since closer proximity between search terms is an indication of greater relevance of the document to the submitted search query.

56. Claims 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of **McGraw et al.** (U.S. Patent Application Publication 2004/0220935).

57. Regarding claims 32 and 33, **Bradford**, **Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method including embedding a watermark of a URL into the first and second highlighted documents.

McGraw et al., however, teaches a method of embedding a watermark of a URL into the first and second highlighted documents (see drawing Figure 3; see also paragraph [0039]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to embed a URL watermark into a document in order to preserve copyright protections or as an advertisement.

58. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Bradford** (U.S. Patent 6,678,679) in view of **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453) as applied to claims 1, 2, 11, 12, 15, 16, 18-20, 23, 26, 35, 38 and 39 above, and further in view of USPTO[2] ("Form PTO/SB/81 Power of Attorney or Authorization of Agent").

59. Regarding claim 34, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method further comprising receiving a patent attorney registration number and using the patent attorney registration number to automatically complete a user input box.

USPTO[2], however, teaches the use of a patent attorney registration number to automatically complete a user input box (see options to either enter a patent attorney registration number or alternately enter user input boxes comprising firm or individual name, address, city, state, zip, country, telephone and fax numbers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to use a patent attorney registration number to automatically complete a user input box, since this saves the user time and effort entering information that is available elsewhere.

60. Claim 64 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) as applied to claim 63 above, and further in view of **Bradford** (U.S. Patent 6,678,679) in view of **Varadarajan** (U.S. Patent Application Publication 2005/0283453).

61. Regarding claim 64, **Bradford** teaches a method of searching for prior art substantially as claimed, comprising:

- a) receiving a first synonym list from a prior art searcher, the first synonym list including a first text string and a second text string (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- b) receiving a second synonym list from a prior art searcher, the second synonym list including a third text string and a fourth text string (see disclosure that the user can enter any number of text strings as a query, col. 5, lines 46-48; see also drawing Figure 1);
- c) executing a database query based on the first synonym list and the second synonym list to produce a query result, the query result identifying a first

document and a second document (see disclosure that the query is executed and documents are retrieved, col. 5, lines 55-57; see also drawing Figure 2);

d) calculating the number of occurrences of each of the text strings in each of the documents (see col. 5, lines 60-65); and

e) transmitting data indicative of a chart based on the total numbers of occurrence of the text strings in the documents (see drawing Figure 2).

Bradford does not explicitly teach a method wherein the input synonym lists are treated as a single concept for the purposes of querying.

Morgan et al., however, teaches a system wherein concepts are represented as a number of 'standard concept phrases', which include common synonyms, misspellings and abbreviations (see paragraph 13, lines 1-6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize synonyms when searching for relevant documents, since failure to include all variants of a search term in a query will result in incomplete results (see **Bradford**, col. 1, lines 45-60).

Neither **Bradford** nor **Morgan et al.** explicitly teaches highlighting all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color.

Varadarajan, however, teaches a system that includes highlighting all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color (see paragraph [0005], lines 1-5; see also paragraph [0029], lines 6-11).

It would have been obvious to one of ordinary skill in the art at the time of the invention to highlight all of the terms indicative of a first concept in one color and all of the terms indicate of a second concept in a second color, since this would enable a user to quickly locate multiple different concepts (see paragraph [0029], lines 6-11).

62. Claims 65 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Morgan et al.** (U.S. Patent Application Publication 2004/0186705) in view of **Bradford** (U.S. Patent 6,678,679) in view of **Varadarajan** (U.S. Patent Application Publication

2005/0283453) as applied to claim 64 above, and further in view of **Jacobson et al.** (U.S. Patent 6,363,379).

63. Regarding claim 65, **Bradford, Morgan et al.** and **Varadarajan** teach a method substantially as claimed.

None of **Bradford, Morgan et al.** nor **Varadarajan** explicitly teach a method that uses the ranking being based upon the logarithms of the number of occurrences of the text strings in the documents.

Jacobson et al., however, teaches the use of the logarithm function to achieve a flattening effect (see col. 3, lines 32-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to use the logarithm functions in ranking, since the mere occurrence of a term of interest in a document in the absolute sense is more significant than the occurrence of said term one additional time, and the use of the logarithm function in determining ranking reflects this fact.

64. Regarding claim 66, **Bradford** additionally teaches a method including ranking the documents based upon the numbers of occurrence of the text strings in the documents when the number of zero count elements associated with the first document is equal to the number of zero count elements associated with the second document (see disclosure that all other things being equal, documents containing more terms of interest should be ranked more highly than documents containing fewer terms of interest, col. 12, lines 54-56).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luke S. Wassum whose telephone number is 571-272-4119. The examiner can normally be reached on Monday-Friday 8:30-5:30, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R. Cottingham can be reached on 571-272-7079. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

In addition, INFORMAL or DRAFT communications may be faxed directly to the examiner at 571-273-4119. Such communications must be clearly marked as INFORMAL, DRAFT or UNOFFICIAL.

Customer Service for Tech Center 2100 can be reached during regular business hours at (571) 272-2100, or fax (571) 273-2100.

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